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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91214508
Party	Plaintiff Tekni-Plex, Inc.
Correspondence Address	CARRIE WEBB OLSON DAY PITNEY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110 UNITED STATES cdoconnor@daypitney.com, colson@daypitney.com, trade- marks@daypitney.com
Submission	Motion to Consolidate
Filer's Name	Catherine Dugan O'Connor
Filer's e-mail	trademarks@daypitney.com, cdoconnor@daypitney.com, colson@daypitney.com, jlanzano@daypitney.com
Signature	/Catherine Dugan O'Connor/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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TEKNI-PLEX, INC.,)	
)	Opposition No. 91214508
)	
Opposer,)	
)	
v.)	
)	
SELIG SEALING PRODUCTS, INC.,)	Serial No. 86/001725
)	Filed July 3, 2013
Applicant.)	Mark: EDGE PULL
)	

OPPOSER’S MOTION TO CONSOLIDATE

Pursuant to TBMP § 511 and Fed. R. Civ. P 42(a), opposer, Tekni-Plex, Inc., (“Tekni-Plex” or “Opposer”), hereby moves to consolidate this proceeding with the nearly identical proceeding, Opposition No. 91215874 brought by Opposer against Selig Sealing Products, Inc.’s (“Selig” or “Applicant”) application to register the mark EDGEPEEL. As explained in more detail below, these two proceedings involve identical parties, nearly identical marks, and common issues of law and fact, such that consolidation will result in considerable savings of time, effort and expense. Accordingly, in the interests of convenience, efficiency, and judicial economy, Opposer requests that the Board consolidate this proceeding with proceeding No. 91215874.

BACKGROUND

On July 3, 2013, Selig filed intent-to-use applications for the marks EDGE PULL and EDGEPEEL. Each of these applications covered the identical goods, namely, “Primarily non-metal seals comprised of various layers including a metallic foil layer for use in container closures and caps” in International Class 17. On January 16, 2014, Tekni-Plex filed Opposition Proceeding No. 91214508 against Selig’s application to register EDGE PULL, based on Tekni-

Plex's priority of use of the EDGE PULL mark with the same type of goods, and a likelihood of confusion that would result should the Selig application proceed to registration. Thereafter, Tekni-Plex also opposed Selig's application to register EDGE PEEL, based on the same grounds, i.e., Tekni-Plex's priority of use in and to the EDGE PULL mark and a likelihood of confusion that would result between EDGE PEEL and EDGE PULL if Selig's application for EDGE PEEL were allowed.

Each opposition proceeded through case planning, initial disclosures and discovery. During these proceedings, Tekni-Plex proposed on multiple occasions that the two cases be consolidated, but was unable to elicit Selig's agreement to consolidate.¹ Discovery concluded in both matters approximately 6 weeks ago, and each case will be entering the plaintiff's testimony period in the near future. Given Selig's failure to provide any documentary or other evidence in discovery that could support its alleged *bona fide* intent to use either EDGE PULL or EDGE PEEL in commerce, Tekni-Plex is moving concurrently herewith to amend each Notice of Opposition to add lack of *bona fide* intent to use the marks in commerce and for summary judgment on this ground.

ARGUMENT

A. Legal Standard

Where separate proceedings involve a common question of law or fact, the Board may order that the cases be consolidated. *See* TBMP § 511; Trademark Rule 2.116(a); Fed. R. Civ. P. 42(a). In considering whether to consolidate, the Board is to balance the savings in time, effort, and expense that may result from consolidation against any prejudice or inconvenience that may

¹ In view of discussions regarding a potential resolution of these matters, Tekni-Plex did not move at an earlier date to consolidate. As explained below, consolidation is particularly appropriate at this juncture, when the cases are poised to move into the summary judgment and potentially trial phases.

occur. *Id.*; see *S. Indus. Inc. v. Lamb-Weston Inc.*, 45 U.S.P.Q.2d 1293, 1297 (TTAB 1997) (consolidation ordered where pleadings were nearly identical).

B. The EDGE PULL and EDGE PEEL Proceedings Involve Common Questions of Law and Fact

There can be no dispute that the opposition proceedings for the EDGE PULL and EDGE PEEL marks involve common questions of law and fact. Both oppositions are based on the same grounds, namely, priority and likelihood of confusion with Tekni-Plex's EDGE PULL mark and, if Tekni-Plex is granted leave to amend its notices of opposition, Selig's lack of *bona fide* intent to use the marks in commerce, demonstrated by its failure to produce any evidence of intent to use in either proceeding.

Indeed, in addition to involving identical parties, the allegations of each Notice of Opposition are virtually identical. For example, each Notice of Opposition alleges that Tekni-Plex adopted the EDGE PULL mark for use with adhesive seals for packaging, also known as closure liner/seal products, of the type identified in Selig's applications, in April of 2012. Tekni-Plex began to use the EDGE PULL mark in marketing, promotion, and product testing at various client's facilities. It is Tekni-Plex's position that through such activities it established goodwill and exclusive rights in and to the EDGE PULL mark, well before Selig, its competitor, filed its applications for the marks at issue in these proceedings more than a year later, on July 3, 2013. Thus, Tekni-Plex has priority in EDGE PULL, and Selig's applications for both EDGE PULL and EDGE PEEL should be refused, in view of the likelihood of confusion between the Tekni-Plex mark, on the one hand, and the Selig marks, on the other.

Unless these matters are consolidated, the Board will be required to consider the exact same evidence and make findings on the exact same facts as to the use that Tekni-Plex made of the EDGE PULL mark, the manner of such use, and the dates of such use. The Board will be

required to consider the same legal question in each case, namely, whether Tekni-Plex's use constituted use in commerce, or analogous use, before Selig's priority date. Selig's priority date, July 3, 2013, is identical for both EDGEPULL and EDGEPEEL.

Moreover, both opposition proceedings involve nearly identical marks, i.e., EDGEPULL and EDGEPEEL. Where cases involve the same parties, similar marks, and virtually identical pleadings, the Board has consistently ordered consolidation to avoid duplication of effort concerning the common factual and legal issues. *E.g.*, *Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 U.S.P.Q.2d, 1889, at *4 (T.T.A.B. 2010) (consolidating oppositions against the marks "VISUALDNA" and "VISUALDNA SHOPS"); *Plus Prods. v. Med. Modalities Assoc., Inc.*, 211 U.S.P.Q. 1199, 1201 (TTAB 1981) (granting opposer's motion to consolidate oppositions to ZN-PLUS for a zinc supplement, MN-PLUS for a manganese protein complex, and CA-PLUS for a calcium protein complex). In this case, Tekni-Plex seeks to consolidate its oppositions to registration of the marks EDGEPULL and EDGEPEEL, both in standard characters. The applications are for the identical goods in Class 17. Further, the marks themselves are nearly identical, with the only difference being in the middle two letters of the second word in each combined mark.

Likewise, Tekni-Plex's claims that the applications are void for lack of *bona fide* intent to use the marks share various facts, including Selig's admissions that it made no use of either mark in commerce, its identical interrogatory responses, and failure to produce documentary evidence relating to alleged *bona fide* intent to use the mark in either case. The legal questions also are the same in both proceedings, as illustrated by the virtually identical pleadings and summary judgment motions being filed in each case.

C. Consolidation Will Avoid Duplication of Effort, Promote Economy and Avoid the Risk of Inconsistent Outcomes

A main purpose behind consolidation is to avoid the needless waste of time, effort and expense. *See* TBMP §511. Without consolidation, the Board and the parties will be required to duplicate efforts by having the same evidence and issues considered in separate proceedings, leading to waste of resources. There is also a risk of inconsistent outcomes, if the interlocutory attorney in one case decides issues differently than the interlocutory attorney in the other case. Consolidation thus is appropriate in the interest of both economy and fairness. *See, e.g., Ritchie v. Simpson*, 41 U.S.P.Q.2d 1859, 1860 (TTAB 1996), *rev'd on other grounds*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (“Inasmuch as the notices of opposition are virtually identical and present common questions of law and fact, despite the variations in the marks and goods involved, the Board has found it appropriate to consolidate the cases.”).

Finally, the procedural posture of these cases supports consolidation. Both cases are closely aligned in terms of their schedules, with discovery having concluded recently and the testimony periods set to commence in the coming month. In fact, the schedules in place in each case are nearly identical, being only five days apart. Given this, and the multiple common questions present in these cases, Tekni-Plex submits that consolidation would not cause any prejudice or inconvenience. Instead, consolidation would promote efficiency, economy and fairness.

CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board enter an Order pursuant to TBMP §511, Trademark Rule 2.116(a) and Fed. R. Civ. P. 42(a) consolidating Opposition No. 91215874 with Opposition No. 91214508 and granting such other relief as the Board deems appropriate.

Respectfully submitted,

TEKNI-PLEX, INC.



By: _____

DAY PITNEY LLP

Carrie Webb Olson

Catherine Dugan O'Connor

One International Place

Boston, MA 02110

Telephone: (617) 345-4767

Facsimile: (617) 206-9338

Email: trademarks@daypitney.com

colson@daypitney.com

cdoconnor@daypitney.com

CERTIFICATE OF SERVICE

I hereby certify that on this date a true and correct copy of the foregoing was served upon the attorney of record for the Applicant by electronic mail, as agreed to between the parties, as follows:

Joseph T. Nabor
FITCH, EVEN, TABIN & FLANNERY, LLP
120 S. Lasalle St. Ste 1600
Chicago, IL 60603
jtnabo@fitcheven.com
trademark@fitcheven.com



Catherine Dugan O'Connor